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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,526	12/13/2001	R. Dennis Nesbitt	P-5512	4775
24492	7590	01/13/2004	EXAMINER	
THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY			GORDON, RAEANN	
P.O. BOX 901 425 MEADOW STREET CHICOPEE, MA 01021-0901			ART UNIT	PAPER NUMBER
			3711	
DATE MAILED: 01/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

S/

Office Action Summary	Application No.	Applicant(s)	
	10/015,526	NESBITT, R. DENNIS	
	Examiner Raeann Gorden	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 December 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 6 is/are allowed.

6) Claim(s) 1-5 and 7-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

<input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (5,984,806). Regarding claim 1, Sullivan discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The inner cover layer is equivalent to applicant's outer core layer. The inner cover layer includes a high-density region (figs 3 and 3B). As shown in the figures the high-density regions are located at the center of the golf ball, which is equivalent to applicant's location centered about the horizontal spin axis. Compare apps figure 3 and Sullivan's figure 3. Regarding claim 2, the high-density regions comprise a continuous or discontinuous band of high-density regions (see figures 4 and 8). Regarding claim 3, the band or high-density regions are disposed in the inner cover (apps outer core layer). Regarding claims 4 and 7-9, Sullivan discloses a band comprising two or more equally segmented parts as shown in the section of the golf ball in applicant's figure 10. Figure 8 of Sullivan displays a golf ball with two high-density bands that intersect in two locations. A section view of the golf ball would create a band comprising four equally segmented high-density regions identical to applicant's figure 10. Regarding claim 5, the weighting

material is visible along the ball exterior (col. 7, lines 50-52). Regarding claim 10, figure 9 of Sullivan discloses 4 high-density bands, which in section view is equivalent to a high-density band comprising 8 equally spaced high-density regions. The golf ball includes an outer cover layer (fig 1). Regarding claim 11, Sullivan discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The inner cover layer is equivalent to applicant's outer core layer. The inner cover layer includes a high-density region extending around the longitudinal axis of the core perpendicular to the ball's spin axis. (figs 8). Regarding claims 12 and 13, the filler may be any type with a high specific gravity, such as tungsten, which has a specific gravity of 19.35 (see col. 25). Regarding claim 14, the high-density regions comprise a continuous or discontinuous band of high-density regions (4 and 8). Regarding claim 15, Sullivan discloses a band comprising two or more equally segmented parts as shown in the section of the golf ball in applicant's figure 10. Figure 8 of Sullivan displays a golf ball with two high-density bands that intersect in two locations. A section view of the golf ball would create a band comprising four equally segmented high-density regions identical to applicant's figure 10. Regarding claim 16, Sullivan discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The inner cover layer is equivalent to applicant's outer core layer. Regarding claims 17 and 18, the high-density band is continuous metal band (fig 8). Col. 25 discloses metals such as aluminum (sp. 2.7) and nickel (sp. 8.9) used in the high-density region. Regarding claim 19, Sullivan discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The inner cover layer is equivalent to applicant's outer core layer. The

inner cover layer includes a high-density region (figs 3 and 3B). As shown in the figures the high-density regions are located at the center of the golf ball, which is equivalent to applicant's location centered about the spin axis. Compare apps figure 3 and Sullivan's figure 3. Regarding claim 20, the golf ball includes an outer cover layer. Although Sullivan does not disclose the horizontal spin axis of the ball the placement of the high density regions appears to be the same as applicant's. One of ordinary skill in the art would have varied the placement of the high density regions to achieve the desired spin characteristics.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11-13, 16, 18, and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 16 of U.S. Patent No. 6,261,193. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the '193 patent anticipates the present invention.

Terminal Disclaimer

The terminal disclaimer filed on 10-23-03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,261,193 has been reviewed and is NOT accepted.

The terminal disclaimer does not comply with 37 CFR 1.321(b) and/or (c) because:

It is directed to a particular claim or claims, which is not acceptable, since "the disclaimer must be of a terminal portion of the term of the entire [patent or] patent to be granted." See MPEP § 1490.

Allowable Subject Matter

Claim 6 is allowed.

Response to Arguments

Applicant's arguments filed 10-23-03 have been fully considered but they are not fully persuasive. The 102 rejection has been replaced with a 103 rejection because Sullivan fails to disclose the horizontal spin axis of the ball. Applicant argues the present invention is entirely different from the Sullivan patent. However, the invention as claimed does not appear to be different from Sullivan's golf ball. Applicant claims a high density region disposed along a common plane and centered about the horizontal

axis. From the figures disclosed by Sullivan, in particular figures 7 and 8, the high density regions would obviously rotate about the horizontal spin axis once put into motion. Applicant may file test data proving the high density regions shown by Sullivan are not centered about the horizontal spin axis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Raeann Gorden
Examiner
Art Unit 3711

rg
January 9, 2004